

IN THE UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA

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MINNETONKA MOCCASIN  
COMPANY, INC.,

Court File No. \_\_\_\_\_

TM Reg # 3,081,684

Plaintiff,

**COMPLAINT**

v.

(Jury Trial Demanded)

TARGET CORPORATION and  
E.S. ORIGINALS, INC.,

Defendants.  
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Plaintiff Minnetonka Moccasin Company, Inc. ("Minnetonka Moccasin" or "Plaintiff")  
for its Complaint against Defendants Target Corporation ("Target") and E.S. Originals, Inc.  
("ESO") (collectively, "Defendants"), states and alleges as follows:

**NATURE OF THE ACTION**

1. This is an action for trademark infringement, trade dress infringement, and unfair competition under the Lanham Act, 15 U.S.C. §§ 1051 *et seq.*, deceptive trade practices under the Minnesota Uniform Deceptive Trade Practices Act, Minn. Stat. § 325D.43 *et seq.*, unlawful trade practices in violation of Minn. Stat. § 325D.13, common law trademark infringement, and common law unfair competition.

**JURISDICTION AND VENUE**

2. The Court has jurisdiction over this action under 15 U.S.C. § 1121, 28 U.S.C. § 1338(a) and (b), 28 U.S.C. § 1331, and 28 U.S.C. § 1367.

3. Venue is proper in this District under 28 U.S.C. § 1391.

**THE PARTIES**

4. Minnetonka Moccasin is a Minnesota corporation with its principal place of business in Minneapolis, Minnesota. Minnetonka Moccasin produces shoes, clothing and accessories, including its well-known moccasin shoe with the iconic thunderbird design. Minnetonka Moccasin sells its products worldwide.

5. Upon information and belief, Target is a Minnesota corporation with its principal place of business in Minneapolis, Minnesota. Upon information and belief, Target engaged in the infringing and unlawful conduct described below.

6. Upon information and belief, ESO is a New York corporation with its principal place of business in New York, New York. Upon information and belief, ESO supplied Target with the infringing moccasins and engaged in the unlawful conduct described below.

**MINNETONKA MOCCASIN'S VALUABLE INTELLECTUAL PROPERTY**

7. Minnetonka Moccasin has used its thunderbird design on footwear for more than forty years (hereinafter the "Thunderbird Design Mark"), and sells moccasins bearing its iconic Thunderbird Design Mark worldwide.

8. Since Minnetonka Moccasin first began using the Thunderbird Design Mark in the 1960's, Minnetonka Moccasin continuously and prominently has used the Thunderbird Design Mark on its moccasins. Minnetonka Moccasin's use of the Thunderbird Design Mark is exemplified by the cover and page four of its 2012 catalog, copies of which are attached hereto as Exhibit A.

9. Minnetonka Moccasin owns a federal registration for its Thunderbird Design Mark obtained from the United States Patent and Trademark Office (U.S. Registration No. 3,081,684). A copy of the registration information for the Thunderbird Design Mark publicly

available through the “Trademark Status and Document Retrieval System” is attached hereto as Exhibit B.

10. The validity of Minnetonka Moccasin’s federal trademark registration for the Thunderbird Design Mark, and Minnetonka Moccasin’s exclusive right to use the Thunderbird Design Mark in commerce, are incontestable under 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b).

11. Minnetonka Moccasin has invested substantial resources in the Thunderbird Design Mark to promote its moccasins, to distinguish its moccasins from products provided by others, and to control the public’s perception of the nature and quality of moccasins associated with the Thunderbird Design Mark.

12. As a result of Minnetonka Moccasin’s substantial investment and long use of the Thunderbird Design Mark, consumers recognize moccasins bearing the Thunderbird Design Mark as Minnetonka Moccasin’s footwear.

13. Minnetonka Moccasin’s successful promotion and use of the Thunderbird Design Mark has created substantial and valuable goodwill to the benefit of Plaintiff.

14. In addition to trademark rights to the Thunderbird Design Mark, Minnetonka Moccasin owns distinctive trade dress that consists of a beaded design, in the shape of a thunderbird, located on the top, front of moccasins (hereinafter “Thunderbird Trade Dress”).

15. Minnetonka Moccasin consistently and continuously has used the Thunderbird Trade Dress on moccasins for more than forty years.

16. Minnetonka Moccasin has invested substantial resources in the Thunderbird Trade Dress to promote its products, to distinguish its products from products provided by others, and to control the public’s perception of the nature and quality of the products associated with the Thunderbird Trade Dress.

17. The Thunderbird Trade Dress has acquired distinctiveness, is non-functional, and serves primarily as a designator of moccasins made or sponsored by Minnetonka Moccasin.

18. As a result of Minnetonka Moccasin's substantial investment and long use of the Thunderbird Trade Dress on moccasins, consumers recognize that moccasins bearing the Thunderbird Trade Dress are made or sponsored by Minnetonka Moccasin.

19. Minnetonka Moccasin's successful promotion and use of the Thunderbird Trade Dress has created substantial and valuable goodwill to the benefit of Plaintiff.

#### **DEFENDANTS' UNLAWFUL CONDUCT**

20. Target and ESO had constructive notice of Minnetonka Moccasin's ownership of the Thunderbird Design Mark through Minnetonka Moccasin's federal registration.

21. In June 2004, Minnetonka Moccasin provided Target with actual notice of Minnetonka Moccasin's trademark rights in the Thunderbird Design Mark.

22. Upon information and belief, Target has knowledge of the valuable goodwill represented by Minnetonka Moccasin's Thunderbird Design Mark and Thunderbird Trade Dress, and that consumers rely upon the Thunderbird Design Mark and Thunderbird Trade Dress to distinguish Minnetonka Moccasin's footwear from the products of others.

23. In November 2011, Target contacted Minnetonka Moccasin and made multiple proposals to sell moccasins made by Minnetonka Moccasin in Target stores, offering "prime real estate on the floor" of Target stores for the moccasins made by Minnetonka Moccasin.

24. Minnetonka Moccasin promptly and politely passed on the sales opportunities presented by Target.

25. In early 2012, despite Target's knowledge of Minnetonka Moccasin's prior and superior rights in the Thunderbird Design Mark and Thunderbird Trade Dress, Target began marketing and selling in its stores moccasins with a beaded thunderbird design nearly identical to Minnetonka Moccasin's Thunderbird Design Mark and Thunderbird Trade Dress:



Target's Moccasin



Minnetonka Moccasin's Moccasin

26. The beaded thunderbird design that Defendants use on moccasins offered for sale by Target (the "Infringing Thunderbird Design") is confusingly similar to Minnetonka Moccasin's iconic Thunderbird Design Mark and Thunderbird Trade Dress.

27. Upon information and belief, ESO is the supplier or sourcing agent of the moccasins with the Infringing Thunderbird Design and offered for sale by Target.

28. Upon information and belief, Target willfully and intentionally chose the Infringing Thunderbird Design to trade off the valuable goodwill of Minnetonka Moccasin's Thunderbird Design Mark and Thunderbird Trade Dress.

29. Upon information and belief, Defendants began use of the Infringing Thunderbird Design with knowledge of the prior ownership by Minnetonka Moccasin of the Thunderbird

Design Mark, and Minnetonka Moccasin's superior rights to use and control use of the Thunderbird Design Mark.

30. Defendants' use of the Infringing Thunderbird Design on the moccasins offered for sale by Target has caused and will continue to cause consumer confusion, deception or mistake, and creates the false impression that Defendants' moccasins with the Infringing Thunderbird Design are associated with or emanate from Minnetonka Moccasin.

31. Upon information and belief, Defendants' use of the Infringing Thunderbird Design on their moccasins is likely to diminish the goodwill associated with Minnetonka Moccasin's Thunderbird Design Mark and Thunderbird Trade Dress.

32. Defendants' use of the Infringing Thunderbird Design is without consent, permission, authorization or license by Minnetonka Moccasin.

#### **COUNT I**

#### **Trademark Infringement in Violation of the Lanham Act, 15 U.S.C. § 1114**

33. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 32 above.

34. Minnetonka Moccasin's Thunderbird Design Mark is valid, incontestable, and distinctive.

35. Defendants' moccasins bearing the Infringing Thunderbird Design are advertised, offered for sale, or sold in interstate commerce.

36. Defendants' unauthorized use of the Infringing Thunderbird Design on their moccasins has caused and is likely to continue to cause confusion, mistake, or deception as to the source or origin of Defendants' moccasins, as customers and potential customers are likely to believe that the moccasins with the Infringing Thunderbird Design are provided, sponsored,

approved, or licensed by Minnetonka Moccasin, or that such moccasins are otherwise affiliated or associated with Minnetonka Moccasin.

37. Defendants' unauthorized use of the Infringing Thunderbird Design constitutes trademark infringement under the Lanham Act, 15 U.S.C. § 1114.

38. Upon information and belief, Defendants acted deliberately and willfully in an attempt to trade upon the goodwill associated with Minnetonka Moccasin's Thunderbird Design Mark.

39. Defendants' unlawful conduct is causing, and will continue to cause, irreparable harm to Minnetonka Moccasin unless enjoined by this Court.

40. Defendants' unlawful conduct has caused damage to Minnetonka Moccasin in an amount to be proven at trial.

41. Pursuant to 15 U.S.C. § 1117, Minnetonka Moccasin is entitled to recover the costs of this action. The nature of Defendants' unlawful conduct renders this an "exceptional case," entitling Minnetonka Moccasin to an award of attorneys' fees under 15 U.S.C. § 1117(a).

**COUNT II**  
**Unfair Competition in Violation of the Lanham Act, 15 U.S.C. § 1125(a)**

42. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 41 above.

43. Defendants' unauthorized use of the Infringing Thunderbird Design constitutes unfair competition under the Lanham Act, 15 U.S.C. § 1125(a).

44. Defendants' unlawful conduct is causing, and will continue to cause, irreparable harm to Minnetonka Moccasin unless enjoined by this Court.

45. Defendants' unlawful conduct has caused damage to Minnetonka Moccasin in an amount to be proven at trial.

46. Pursuant to 15 U.S.C. § 1117, Minnetonka Moccasin is entitled to recover the costs of this action. The nature of Defendants' unlawful conduct renders this an "exceptional case," entitling Minnetonka Moccasin to an award of attorneys' fees under 15 U.S.C. § 1117(a).

**COUNT III**

**Trade Dress Infringement in Violation of the Lanham Act, 15 U.S.C. §1125(a)**

47. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 46 above.

48. Minnetonka Moccasin has used its distinctive and non-functional Thunderbird Trade Dress to distinguish its moccasins from moccasins offered by other companies.

49. Defendants' use of the beaded Infringing Thunderbird Design located on the top front of the moccasins offered for sale in interstate commerce constitutes infringement of Minnetonka Moccasin's Thunderbird Trade Dress and violates the Lanham Act, 15 U.S.C. § 1125(a)(1).

50. Defendants' wrongful conduct has caused and is likely to continue to cause confusion, mistake, or deception as to the source or origin of Defendants' products, as customers and potential customers are likely to believe that Defendants' moccasins with the beaded Infringing Thunderbird Design located on the front, top of the moccasins are provided, sponsored, approved, or licensed by Minnetonka Moccasin, or otherwise affiliated or associated with Minnetonka Moccasin.

51. Upon information and belief, Defendants acted deliberately and willfully in an attempt to trade upon the goodwill associated with Minnetonka Moccasin's Thunderbird Trade Dress.

52. Defendants' unlawful conduct is causing, and will continue to cause, irreparable harm to Minnetonka Moccasin unless enjoined by this Court.



53. Defendants' unlawful conduct has caused damage to Minnetonka Moccasin in an amount to be proven at trial.

54. Pursuant to 15 U.S.C. § 1117, Minnetonka Moccasin is entitled to recover the costs of this action. The nature of Defendants' unlawful conduct renders this an "exceptional case," entitling Minnetonka Moccasin to an award of attorneys' fees under 15 U.S.C. § 1117(a).

**COUNT IV**  
**Violation of Minnesota Uniform Deceptive Trade Practices Act**

55. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 54 above.

56. Minnetonka Moccasin's Thunderbird Design Mark and Thunderbird Trade Dress are "trademarks" as defined in Minn. Stat. § 325D.43.

57. Defendants' use, in their respective courses of business, of the Infringing Thunderbird Design on the moccasins they offer for sale is intended to pass off such goods as those of Minnetonka Moccasin, and is likely to cause confusion or misunderstanding as to the source of Defendants' products, as customers and potential customers are likely to believe there is sponsorship, approval, affiliation, connection, or association between Defendants' moccasins with the Infringing Thunderbird Design and Plaintiff's moccasins with the Thunderbird Design Mark and the Thunderbird Trade Dress.

58. Defendants' actions alleged herein constitute deceptive trade practices in violation of Minn. Stat. § 325D.44.

59. Upon information and belief, Defendants have willfully undertaken their actions knowing them to be deceptive.

60. Defendants' unlawful conduct has caused and will continue to cause irreparable harm and other damage to Minnetonka Moccasin if Defendants' conduct is not enjoined.

61. As a result of Defendants' wrongful and knowing deceptive trade practices, Minnetonka Moccasin is entitled to an injunction and to recover its costs and attorneys' fees pursuant to Minn. Stat. § 325D.45.

**COUNT V**  
**Unlawful Trade Practices in Violation of Minn. Stat. § 325D.13**

62. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 61 above.

63. Upon information and belief, Defendants' use of the Infringing Thunderbird Design on their moccasins knowingly misrepresents, directly or indirectly, the origin of their moccasins.

64. Defendants' actions alleged herein constitute unlawful trade practices in violation of Minn. Stat. § 325D.13.

65. As a direct and proximate result of Defendants' unlawful trade practices, Minnetonka Moccasin has suffered and will continue to suffer irreparable harm if Defendants' conduct is not enjoined.

66. Defendants' unlawful conduct has caused damage to Minnetonka Moccasin in an amount to be proven at trial.

**COUNT VI**  
**Common Law Trademark Infringement**

67. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 66 above.

68. Defendants' actions constitute trademark infringement under the common law.

69. As a direct and proximate result of the likelihood of confusion, mistake, or deception caused by Defendants' unlawful conduct, Minnetonka Moccasin has suffered and will continue to suffer irreparable harm if Defendants' conduct is not enjoined.

70. Defendants' unlawful conduct has caused damage to Minnetonka Moccasin in an amount to be proven at trial.

**COUNT VII**  
**Common Law Unfair Competition**

71. Plaintiff repeats and incorporates herein the allegations of Paragraphs 1 through 70 above.

72. The acts of Defendants complained of herein constitute unfair competition in violation of the rights of Minnetonka Moccasin.

73. As a direct and proximate result of the unfair competition of Defendants, Minnetonka Moccasin has suffered and will continue to suffer irreparable harm if Defendants' conduct is not enjoined.

74. Defendants' unlawful conduct has caused damage to Minnetonka Moccasin in an amount to be proven at trial.

**DEMAND FOR JURY TRIAL**

Plaintiff hereby demands a trial by jury of all issues so triable.

**PRAYER FOR RELIEF**

WHEREFORE, Minnetonka Moccasin respectfully asks the Court to:

A. Permanently enjoin and restrain Defendants and their respective partners, agents, servants, employees and attorneys, and those persons in active concert or participation with Defendants from:

1. Using the Infringing Thunderbird Design on or in connection with the production of, manufacture of, advertisement of, promotion of, display of (including on the Internet), or otherwise the display for sale of, offer for sale of, sale of, or distribution of, any product or service.

2. Representing by any means whatsoever, directly or indirectly, or doing any other acts or things calculated or likely to cause confusion, mistake or to deceive purchasers into believing that Defendants' products or services originate with or are the services or products of Minnetonka Moccasin or that there is any affiliation or connection between Minnetonka Moccasin and its services and products and Defendants and their services and products, and from otherwise competing unfairly with Minnetonka Moccasin.

B. Directing that Defendants, at their own expense, recall all marketing, promotional and advertising materials and edit any websites that bear or incorporate the Infringing Thunderbird Design, or any mark confusingly similar to the Thunderbird Design Mark or trade dress confusingly similar to the Thunderbird Trade Dress.

C. Directing Defendants to remove any infringing products from store shelves and all other retail outlets.

D. Directing that Defendants deliver to Minnetonka Moccasin's attorneys or representatives for destruction all labels, signs, prints, packages, molds, plates, dies, wrappers,

receptacles, and advertisements in their possession or under their control, bearing the Infringing Thunderbird Design or any simulation, reproduction, copy or colorable imitation of the Infringing Thunderbird Design or Thunderbird Trade Dress, and all films, discs, plates, molds, matrices, and any other means of making the same.

E. Directing such other relief as the Court may deem appropriate to prevent the trade and public from forming any erroneous impression that any product promoted or provided by Defendants is authorized by Minnetonka Moccasin or related in any way to Minnetonka Moccasin's products.

F. Directing Defendants to file with this Court and to serve upon Plaintiff within thirty (30) days after service upon Defendants of an injunction in this action, a written report by Defendants, under oath, setting forth in detail the manner in which Defendants have complied with the injunction.

G. Directing Defendants to account to Plaintiff for profits derived by Defendants from the sale of their infringing products and for all damages sustained by Plaintiff by reason of said acts of infringement and unfair competition complained of herein.

H. Awarding Minnetonka Moccasin as damages Defendants' profits from their sales of products bearing the Infringing Thunderbird Design.

I. Awarding Minnetonka Moccasin all damages permitted by 15 U.S.C. § 1117(a), trebled.

J. Awarding Minnetonka Moccasin its damages in an amount to be established at trial.

K. Awarding Plaintiff its reasonable attorney's fees and the costs of this action.

L. Awarding Plaintiff such further relief as this Court deems just and proper.

Dated: September 24, 2012

By: /s/ Jerry S. Podkopacz

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